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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/537,609

06/03/2005

Norihiko Nakahara

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12/16/2008

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EXAMINER

HUNTER, ALVIN A

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

12/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/537,609 | Applicant(s) NAKAHARA ET AL. | |
| | Examiner ALVIN A. HUNTER | Art Unit 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacKay, Jr. et al. (USPN 5904628) in view of Satoh (USPN 6287214) and Okada (JP 2002-17909).

Regarding claim 7, MacKay, Jr. discloses a club head comprising an outer shell member, a hollow portion surrounded by the outer shell member, and a columnar neck member wherein the inner surface of the hollow portion includes a concave surface having no projecting portion formed thereon. MacKay, Jr. does not disclose the columnar neck having an insertion hole for that shaft that is closed at a hollow portion side. Satoh discloses that it is conventional to construct a columnar neck being closed at the hollow portion (See Figure 6 and Background of the invention). Further, Okada shows a club head wherein the inner surface of the shaft insert hole is closed and forms a continuous surface concave surface with the entire inner surface of the club head. One having ordinary skill in the art would have found it obvious to have the insertion hole of the columnar neck closed at the hollow portion, as taught by Satoh and shown by Okada, because it is common within the art.

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Regarding claim 9, MacKay, Jr. discloses a club head comprising an outer shell member, a hollow portion surrounded by the outer shell member, and a columnar neck member wherein the inner surface of the hollow portion includes a concave surface having no projecting portion formed thereon. MacKay, Jr. does not disclose the columnar neck having an insertion hole for that shaft that is closed at a hollow portion side. Satoh discloses that it is conventional to construct a columnar neck being closed at the hollow portion (See Figure 6 and Background of the invention).). Further, Okada shows a club head wherein the inner surface of the shaft insert hole is closed and forms a continuous surface concave surface with the entire inner surface of the club head. One having ordinary skill in the art would have found it obvious to have the insertion hole of the columnar neck closed at the hollow portion, as taught by Satoh and shown by Okada, because it is common within the art. MacKay notes that a shaft having a grip is attached to the club head.

Regarding claims 10 and 11, the limitations are directed to a product by process. Because the final product is the same, it is submitted that MacKay, Jr. et al. meets these limitations.

Response to Arguments

Applicant's arguments with respect to claims 7 and 9-11 have been considered but are moot in view of the new ground(s) of rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumamoto (JP 2004-329676) shows a club head having a shaft insertion hole closed at the inner surface of the club head.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN A. HUNTER whose telephone number is (571)272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alvin A Hunter/

Examiner, Art Unit 3711